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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,353	07/23/2003	Roy Stubbs	50771US006	8599

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EXAMINER

MORGAN, EILEEN P

ART UNIT PAPER NUMBER

3723

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,353

Applicant(s)

STUBBS, ROY

Examiner

Eileen P. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1,3,4,5 are finally rejected under 35 U.S.C. 102(e) as being anticipated by German 9407622.

The German reference discloses a direct coated sponge abrasive material directly bearing a securing hook means.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over German in view of Hong.

The German reference does not disclose the sponge having securing means or loop material or in combination with a strap. However, Hong et al. discloses an abrasive sponge with securing means loop (20) on back side for engagement to hooks, wherein a strap (25) is provided having hook engaging means (24). Therefore, to substitute the ~~sponge~~^{hook} of Germany '622 with loop securing means, as taught by Hong, would have been obvious to one of ordinary skill in the art at time invention was made since both types of securing means work equally well and the choice of either would be within the level of ordinary skill. And, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167. It would have been obvious at the time applicant's invention was made to a person of ordinary skill in the art to use nylon loops based on its suitability for the intended use. In re Leshin, 125 USPQ 416.

7. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over German reference in view of Hong as applied to claims 2,6, 8 above, and further in view of Cheney. Germany '622 and Hong et al. do not teach a back-up pad, however, Cheney et al. teaches a sanding pad (42) with abrasive (50) on one side and on other side to be attached to a back-up pad hook and loop (53) (24) having mating surface (55) for use with a hand or power sander (Abstract). Therefore, it would have been obvious at the time applicant's invention was made to a person of ordinary skill in the art to provide Germany '622 in view of Hong with a back-up pad assembly, as taught by Cheney, in order to perform various sanding operations with one back-up pad while readily changing sanding pads (via hook & loop) of different abrasive nature: It would have been obvious at the time applicant's invention was made to a person of ordinary skill in the art to use nylon loops based on its suitability for the intended use. In re Leshin, 125 USPQ 416.

Response to Arguments

Applicant's arguments filed 8-2-05 have been fully considered but they are not persuasive. Applicant argues that the amendment overcomes the rejection because Jost has embedded abrasive particles in the sponge material and that Applicant amended the specification to exclude abrasive particles within the sponge. However, the Figures are part of the disclosure and clearly show embedded abrasive particles within the sponge material. In addition, the claims do not exclude such abrasive particles being embedded within the sponge and Applicant is relying on the definition in the specification which contradicts the drawings. In the parent case 08/540674, of which the instant application is a continuation-in-part of, the direct coated sponge definition did not mention this exclusion. It appears this exclusion was merely added to try and overcome the prior art of record and appears to be contradictory of itself (Child in view of Parent case). Claim 1 as amended does not exclude abrasive particles from being embedded within the sponge, it only recites the abrasive layer 'comprises...binder with abrasives', this does not exclude embedded abrasive particles. Furthermore, Jost does not appear to show embedded particles within the sponge material as asserted by Applicant. The abrasive particles are shown to be attached to the outer surface with a binder. The top of page 5 of translation, states that the abrasive and binder 'at least in part consists of the foam'. This is no way can be interpreted to say that the abrasive particles are embedded within the foam. It merely means the binder and particles in part consists of the foam where they are attached. Of course the binder is not floating

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in mid-air above the foam, it is bonded to the top surface, therefore, consists 'in part of the foam'. In regard to claim 5, Jost discloses the shape can be rectangular (top of page 4, translation). The Velcro is an 'adapting surface' and therefore is combinable with Hong which shows a Velcro surface for adapting the object to be held. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, the rejections including Hong and Cheney are appropriate. In fact, the Board of Appeals upheld this rejection on May 27, 2003 and did not find the rejections to be made in hindsight.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

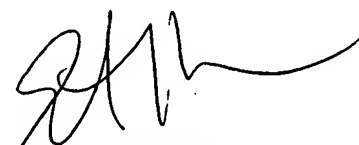
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P Morgan whose telephone number is 571.272.4488. The examiner can normally be reached on Tuesday-Thursday (Office), Friday (Work at home).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EM

October 17, 2005



EILEEN P. MORGAN
PRIMARY EXAMINER